

## **REMARKS/ARGUMENTS**

Amendments were made to the specification to correct errors and to clarify the specification. No new matter has been added by any of the amendments to the specification.

Claims 1-15 are pending in the present application. Claim 14 was canceled; and claims 1-3 were amended. Reconsideration of the claims is respectfully requested.

### **I. 35 U.S.C. § 101: Claim 14**

The Examiner has rejected claim 14 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter.

Applicant has requested claim 14 to be cancelled in view of the subject matter of claim 15; therefore, the rejection of claim 14 as originally filed, is moot.

### **II. 35 U.S.C. § 112, Second Paragraph: Claims 1-15**

The Examiner has rejected claims 1-15 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which Applicants regard as the invention. This rejection is respectfully traversed.

With regard to claims 1-15, the Examiner states “claims 1-15 recites the limitation “said role revealing.” There is insufficient antecedent basis for this limitation in the claim.”

Applicant respectfully traverses the Examiner’s opinion and specifically points to independent claim 1, as originally filed, including the limitation claimed in a positive manner as “...which assigns, based on said user characteristics and said message characteristics, a role of said user to said certain message, said role revealing said user’s relationship to said certain message.” The cited passage clearly indicates the assignment of a role of said user to a certain message, thereby providing proper antecedent support for subsequent claim usage.

With regard to dependent claims 2 and 3, Examiner opined that “claims 2-3 recites the limitation “said user’s userid, said user’s name, said user’s nickname, the contents of TO, the contents of CC, the contents of BCC.” There is insufficient antecedent basis for this limitation in the claim.”

Applicants have provided amended claim 2 to more clearly introduce the subject matter in indefinite form as, for example, “a contents of a TO: field.” Similar changes have been made to clarify the remaining limitations, thereby providing proper antecedent support for subsequent use.

In view of the foregoing and amendments provided herewith, Applicants respectfully submit that the Examiner’s rejection of claims 1-15 has been overcome.

Therefore, the rejection of claims 1-15 under 35 U.S.C. § 112, second paragraph has been overcome.

### **III. Objection to Claims: Claims 1-15**

The examiner has stated that claims 1-15 were objected to due to various informalities. In response, the claims have been rewritten to overcome these objections.

With regard to independent claim 1, amendments have been provided to clarify the subject matter. In particular, a revised format of clause separation, including the Examiner's suggestion to better separate the preamble from the body, allows for increased comprehension.

With regard to dependent claims 2 and 3, claim elements specific to the user, as in original claim 2, have been reworded in a more positive form, such as "a user ID of said user." The revised form also provides proper antecedent support for subsequent use in claim 3.

With further regard to dependent claims 2 and 3, the list of deduction rules has been amended in a manner to read "a first deduction rule ..." in place of "a 1. deduction rule ..." as originally claimed, to further enhance comprehension of the claimed subject matter.

In view of the foregoing and amendments provided herewith, Applicants respectfully submit that the Examiner's objection to claims 1-15 has been overcome.

### **IV. 35 U.S.C. § 102, Anticipation: Claims 1 and 4-15**

The examiner has rejected claims 1 and 4-15 under 35 U.S.C. § 102 as being anticipated by *Paul*, Apparatus and Method for Controlling Delivery of Unsolicited Electronic Mail, U.S. Patent No. 6,052,709 (April 18, 2000) (hereinafter "*Paul*"). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. In re Bond, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. In re Lowry, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case each and every feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims.

The cited reference of *Paul* at col. 1, lines 50-60, is directed to "...a system and method for controlling the delivery of unsolicited electronic mail messages..." In contrast, with regard to independent claim 1, the claimed invention is for "improved handling of messages directed to a user of an

electronic messaging system...” distinguishing over *Paul* by having the message “directed to a user.” *Paul* appears to be more focused on the “FROM” source of the email than the recipient as at col. 6, lines 1-15, and lines 44-49. It is not apparent that *Paul* analyzes the message characteristics as is currently claimed. *Paul* appears to use the message headers to populate an exclusion list as at col. 6, lines 2-6.

The Examiner opines that *Paul* at col. 6, lines 1-43, teaches “applying at least one deduction rule of a potential set of deduction rules to a certain message, which assigns based on said user characteristics and said message characteristics, a role of said user to said message ...” However, *Paul* does not teach use of deduction rules, nor does *Paul* teach assignment of a role of said user to said message. The Examiner states on pages 7-8 of the Office Action dated June 8, 2007 that *Paul* does not explicitly teach use of deduction rules as presently claimed. In contrast with the claimed invention, *Paul* teaches away from the granular capability of the claimed invention. *Paul* teaches “...matching data stored in the corresponding category of the exclusion list manager 202 the e-mail is marked by the filter 204 with a first display code indicating the JUNK status of the message” as at col. 6, lines 47-50. *Paul* primarily teaches a means of collecting messages into a single output category of JUNK.

There is no evidence in the cited reference teaching or other reasoning for the assignment of a role of a user to a message as is currently claimed. *Paul* teaches away from use of user characteristics and employs a “spam probe” as at col. 4, lines 23-34, to collect filtering information later applied to the mass of users as at col. 6, lines 17-25, wherein the “...source data extracted from the alert signals are automatically added to the stored exclusion list.” In contrast the “role,” as in the claimed invention, is a valued element as supported on page 5, 3<sup>rd</sup> paragraph of the description “...knowing the user’s role with respect to a certain message the user can decide in most cases without knowing the details of the message contents (i.e. without having read and understood the message) how and when to deal with that particular message.”

Furthermore, *Paul* does not teach any additional reasons to make the needed changes to reach the presently claimed invention. *Paul* actually teaches away from the presently claimed invention because it teaches a “system and method for controlling of unsolicited electronic mail messages, one or more spam probe e-mail addresses are created and planted at various sites...” opposed to teaching of “a computerized method for improved handling of messages directed to a user of an electronic messaging system, said method comprising: determining user characteristics capable of identifying said user as addressee of a message” as in the presently claimed invention. Absent the examiner pointing out some teaching or reason to implement *Paul* and the teaching of “...applying at least one deduction rule of a potential set of deduction rules to said certain message, which assigns, based on said user characteristics and said message characteristics, a role of said user to said certain message, said role revealing said user’s relationship to said certain message....,” one of ordinary skill in the art would not be led to modify *Paul*

to reach the present invention when the reference is examined as a whole. Absent some teaching, or reason to modify *Paul* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

Since claims 2-15 depend directly or indirectly from claim 1, the same distinctions between *Paul* and the claimed invention in claim 1 apply equally for these claims. Consequently, it is respectfully submitted that the rejection of claims 1 and 4-15 under 35 U.S.C. § 102 has been overcome.

**V. 35 U.S.C. § 103, Obviousness: Claims 2-3**

The examiner has rejected claims 2-3 under 35 U.S.C. § 103 as being unpatentable over *Paul*. This rejection is respectfully traversed.

All limitations of the claimed invention must be considered when determining patentability. In re Lowry, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). In comparing *Paul* to the claimed invention to determine obviousness, limitations of the presently claimed invention may not be ignored. The present invention in claim 2 incorporates subject matter from claim 1 by nature of dependency and further recites: "wherein said user characteristics at least comprise one of the following elements: a user ID of said user in said messaging system; a name of said user; a nickname of said user; and wherein said message characteristics at least comprise one of the following elements: a contents of a TO: field; a contents of a CC: field, identifying addressees receiving a complimentary copy; a contents of a BCC: field, identifying addressees receiving a blind carbon copy; a contents of a body of said message; and wherein said set of deduction rules comprises at least one of the following deduction rules..."

Such a feature is not taught or suggested by *Paul*. Therefore, as claim 3 depends from claim 2, the same distinctions between *Paul* and the claimed invention in claim 2 apply, claims 2-3 are not obvious in view of *Paul*.

Therefore, the rejection of claims 2-3 under 35 U.S.C. § 103 has been overcome.

**VI. Conclusion**

It is respectfully submitted that the subject application is patentable over *Paul* and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: August 29, 2007

Respectfully submitted,

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